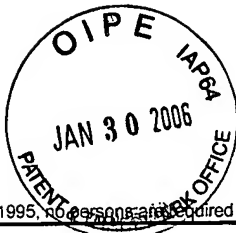


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PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
864.046

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on January 27, 2006

Signature

Jodi A. Calderon

Typed or printed

name Jodi A. Calderon

Application Number

10/672,713

Filed

September 26, 2003

First Named Inventor

Sugden et al.

Art Unit

3671

Examiner

Arpad F. Kovacs

Applicant requests review of the second, non-final, Office Action in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 34400

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34. _____

T. Newholm

Signature

Timothy E. Newholm

Typed or printed name

414.225.9755

Telephone number

January 27, 2006

Date

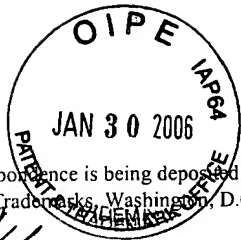
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

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*Total of 1 forms are submitted.

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Jodi A. Calderon

Date: 1-27-06

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.: 10/672,713 Examiner: Arpad F Kovacs
Filing Date: September 26, 2003 Group Art Unit: 3671
Inventor: Sugden et al. Attorney Docket No. 864.046
Assignee: Scag Power Equipment, Inc.
Invention: *LAWN STRIPER*

REMARKS ACCOMPANYING
PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In an Office Action dated July 27, 2005 the Examiner rejected claims 16, 17, 29, 30, 33, and 34 as being unpatentable over the prior art. Specifically, 1) he rejected claims 16, 17, 29, 33, and 34 as being anticipated by Clemson, and 2) he rejected claim 30 as being obvious over Clemson in view of Harris. This was the *second or subsequent* rejection with respect to claims 16, 17, and 29. This case is therefore ripe for appeal.¹ Applicants have filed a Notice of Appeal simultaneously herewith.

The rejections contain clear errors and omissions of one or more essential elements needed for a *prima facie* rejection. As such, applicants hereby request that a pre-appeal brief review be conducted in accordance with the Pre-Appeal Brief Conference Pilot Program that was initiated on July 12, 2005 and extended indefinitely on January 10, 2006.

Briefly described, the invention relates to a "lawn striper" including a roller assembly 20 that is towed behind a frame 22 of a lawnmower 24 to leave decorative stripes in the freshly-cut

¹ 35 USC §134 and 37 CFR §1.191. See also *ex Parte Lemoine*, 46 USPQ2d 1420, 1423 (BPAI 1998) ("Under our interpretation, so long as the applicant has twice been denied a patent, an appeal may be filed.")

grass. In order to permit the operator to choose to either produce or not produce those stripes, the roller assembly 20 can be selectively raised from a lowered, operative position in which the rollers 38 roll along the ground to a stowed, inoperative position in which the rollers 38 cannot contact the ground. The roller assembly 20 can be latched in its inoperative position using a latch such as a spring-biased latch pin 106. The lowered, operative position is illustrated in FIG. 4 and the raised, inoperative position is illustrated in FIG. 5.

The primary reference to Clemson relates not to a lawn striper but to a reel-type lawnmower having rollers that support the lawnmower frame on the ground *at all times* and that that are vertically adjustable relative to the lawnmower frame to adjust the cutting height of the lawnmower. Unlike in the claimed invention, the rollers always engage the ground. Given this fundamental difference between the cited Clemson reference and the claimed invention, it should be no surprise that the Examiner's rejection contains numerous clear errors and/or omissions of elements needed to establish *prima facie* rejections based on anticipation or obviousness. The clear errors and/or omission of essential elements needed for a *prima facie* will now be discussed on a claim-by-claim basis:

1. **Rejection of Independent Claims 16 as being Anticipated by Clemson**

The Examiner's rejection of claim 16 as being anticipated by Clemson contains at least the following errors:

- Paragraph D of claim 16 recites "a latch assembly that is selectively engagable to hold the tow arm in a position that holds the roller assembly in a raised, inoperative position in which the rollers are incapable of riding along a ground surface." In his rejection on paragraph 2 of page 2 of the Office Action, the Examiner states "a latch assembly includes a pin (66)". This statement falls short of meeting the Examiner's burden of making a *prima facie* showing of anticipation because it fails to explain how any structure in the cited Clemson reference "is selectively engageable to hold the tow arm in a position that holds the roller assembly in a raised, inoperative position in which the roller is incapable of riding along a ground surface."

In fact, Clemson is incapable of operating as claimed. The rollers 28 of Clemson are *always*

supported on the ground. The latch pin 66 can simply be operated to permit the mower's cutting height to be adjusted by releasing the latch pin 66 from one of a series of spaced holes 64 and moving the frame 12 relative to the sector plates 34 to a position in which pin 66 engages a different one of the series of spaced holes 64. Nowhere does Clemson disclose that any of the holes 64 are positioned such that the rollers 28 would ever be off the ground. To the extent that the Examiner has ignored the functional language in clause D of claim 16, he has failed to meet his burden of at least explaining how Clemson is *capable* of performing that function, whereupon the burden would have shifted to the Applicants to disprove the Examiner's contention. *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997).

- Clause (D)(ii) of claim 16 requires that the latch assembly be selectively movable to a "second position in which the latch assembly is engaged and the roller assembly is held in a raised, inoperative position thereof." The Examiner fails to address this limitation entirely. As discussed above, the latch pin of Clemson is *incapable* of functioning in the claimed manner because the rollers 28 engage the ground in all positions of the pin 66.
- Claim 16 also recites a tow arm . . . including a front end link having a "front end configured to be at least indirectly supported by a lawnmower frame independently of a cutting deck of the lawnmower." The Examiner alleges that Clemson has a tow arm having a "front link 12" but fails to explain how that alleged link is or can be at least indirectly supported by a lawnmower frame independently of a cutter deck. This was clear error. Applicants also believe that the Examiner erred in referring to element 12 of Clemson as the front of a tow arm because that element is, in reality, part of the lawnmower frame. See col. 2, lines 16-19.

2. Rejection of dependent Claim 17 as being Anticipated by Clemson

Claim 17 depends from claim 16 and requires that the pin be a latch pin that is spring biased to a *retracted* position thereof. The Examiner contends that Clemson's pin 66 is spring biased but fails to explain how it is spring biased into a *retracted* position. Nor can he. Clemson's spring is a "spring pressed latch pin" that is spring biased into an engaging or *extended* position, not into a retracted position as claimed. See, e.g., col. 3, lines 33-36.

3. **Rejection of Independent Claim 29 as being Anticipated by Clemson**

Claim 29 differs from claim 16 primarily in that it recites the combination of a lawnmower and a roller assembly, whereas claim 16 recites the subcombination of a roller assembly *per se*. The rejection of claim 29 contains at least essentially the same errors discussed above in connection with claim 17.

4. **Rejection of Claims 33 and 34 as being Anticipated by Clemson**

Claims 33 and 34 depend from claims 16 and 19, respectively. The rejection of those claims as being anticipated by Clemson is deficient for at least the reasons discussed above in connection with claims 16 and 19.

5. **Rejection of Dependent Claim 30 as being Obvious over Clemson in View of Harris**

Claim 30 depends from claim 29 and, like claim 17, additionally requires that the latch pin be biased into its retracted position. Claim 30 additionally requires that a cross pin be mounted on the latch pin and be capable, depending on the rotational position of the latch pin, of either preventing movement of the latch to the retracted position or permitting that movement. The Examiner acknowledges that Clemson lacks a cross pin configured as claimed and contends that it would have been obvious, in view of Harris, to provide a latch pin “in order to better secure the latch” (Office Action, page 4). Even if the Examiner’s statement were correct, it would still fall short of establishing a *prima facie* case of obviousness because the Examiner fails to indicate how Harris cures the remaining deficiencies of Clemson, discussed above.

Moreover, the element 17 of Harris alleged by the Examiner to correspond to the claimed cross pin is, in fact, a cotter pin. The Examiner fails to explain how that cotter pin is capable, depending on the rotational position of a latch pin, of either preventing movement of a latch pin into the retracted position thereof from the extended position thereof or permitting said movement. Nor could the Examiner meet his burden in this regard since the cotter pin of Clemson is, in fact, incapable of performing that function.

The Examiner’s *prima facie* case is still further deficient in that the Examiner’s purported motivation to combine teaches away from the claimed invention. Specifically, the Examiner

indicates that it would have been obvious to use a cotter pin in Clemson “in order to better secure the latch.” However, in the claimed invention, the cross pin does not act to better secure the latch but, instead, acts to *release* the latch under the biasing force of the spring upon rotation of the latch pin into a position permitting such a release.

CONCLUSIONS

For the above reasons, it is believed that the claims patentably define over the cited references and the Examiner made clear errors and/or omitted essential elements needed for *prima facie* rejections in his Office Action. Reconsideration by the panel, withdrawal of the rejections, and allowance of the application are therefore believed in order and are respectfully requested.

Respectfully submitted,



Timothy Newholm
Registration No. 34,400

Dated: January 28, 2006

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